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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SC11499TS	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>October 24, 2005</u> Signature <u>Stacie Herrera</u> Typed or printed name <u>Stacie Herrera</u>		Application Number 09/847,487	Filed 05/02/2001
		First Named Inventor Alex S. Koh, et al	
		Art Unit 2123	Examiner Kandasamy Thangavelu
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30,163</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>James L. Clingan, Jr.</u> Signature James L. Clingan, Jr. Typed or printed name <u>(512) 996-6839</u> Telephone number <u>10/24/05</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>5</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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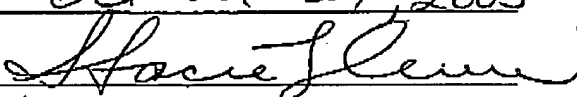
UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 24 2005

APPLICANT(S) Alex S. Koh et al GROUP ART UNIT: 2123
APPLN. NO.: 09/847,487 EXAMINER: Kandasamy Thangavelu
FILED: May 2, 2001
TITLE: METHOD FOR PRODUCTIVE TEST PATTERNS FOR TESTING AN
INTEGRATED CIRCUIT

Certificate of Transmission under 37 CFR 1.8

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on October 24, 2005

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Stacie Herrera
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STATEMENT OF REASONS FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Advisory Action dated September 20, 2005, the preceding Office
Action dated August 2, 2005, and the Examiner's comments with regard thereto, Applicants
herewith submit a Pre-Appeal Brief Request for Review and an accompanying statement.

STATEMENT

In the Office Action, made final, the Examiner rejected claims 1-27 under 35 U.S.C. 103 as being obvious. Claims 1-27 remain under examination.

In this regard, Araki and Gruodis are the two main references used in rejecting all of the claims although some claims are rejected based on additional references. The independent are rejected based on only Araki and Gruodis.

Araki only describes testing a simulation although applicants certainly admit that testing a simulation is with a view to making an integrated circuit that itself will be tested. Araki describes a system similar to that admitted as prior art in applicants' prior art FIG. 1. This is a system that simply tests a simulation and captures only the results of the test itself. Gruodis, on the other hand, describes only testing an integrated circuit. Gruodis describes that in the course of testing the integrated circuit, opcodes are generated for the purpose of providing directions to the IC tester. The Examiner argued that since using opcodes is known for testing an integrated circuit it would be obvious to use opcodes for testing a simulation. What the Examiner argues is obvious still does not meet any of applicants' independent claims because it still doesn't result in taking the opcodes from the simulation and using them in the testing of the integrated circuit.

Further, applicants submit that the Examiner's conclusion that it would be obvious to use the opcodes generated in testing the integrated circuit in the testing of the simulation is not proper. The opcodes of Gruodis are for directing the IC tester. Such opcodes have no utility in testing the simulation in Araki. The approach described by Araki for testing a simulation would simply have no use for opcodes especially because the Araki approach of testing a simulation does not have anything in it that would be able make use of opcodes. Notice in particular that Tester Opcodes are not present in the Dump File Storage-25 of Araki. The Dump File Storage is generated from the Logic Simulation-22 which has no use for Tester Opcodes, and thus they are not present. Similarly, for the system of applicants' prior art FIG. 1, there is nothing in the testing of the simulation that could make use of opcodes. Accordingly, applicants submit that there is simply no incentive or suggestion to combine the opcodes of Gruodis with the simulation testing systems of Araki therefore independent claims 1, 12, 18, and 22 are patentably distinct from the combination of Araki and Gruodis.

With this understanding the dependent claims should be analyzed differently as well.

Conclusion


Applicants believe the application is in condition for allowance which action is respectfully solicited. Please contact the below-signed if there are any issues regarding this communication or otherwise concerning the current application.

Respectfully submitted,

SEND CORRESPONDENCE TO:

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Law Department

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